

REMARKS

Applicant hereby submits a Supplemental Information Disclosure Statement for consideration by the Examiner.

Claims 1-9 have been canceled. Claims 10-28 are new. Support for the amendments can be found throughout the specification. No new matter has been added hereby.

Claim Rejections

Claims 1-9 stand rejected under 35 U.S.C. § 101 as directed to nonstatutory subject matter. Although the undersigned does not agree with the PTO's position on the patentability of insurance policies, claims 1-9 have been canceled, so this rejection is now moot. Moreover, Applicant respectfully submits that new claims 10-28 are all directed to statutory subject matter, in particular: computerized methods, business methods, and data processing apparatus, all of which produce a concrete, tangible and useful result. Computerized methods and business methods have been expressly approved as patentable subject matter by the Court of Appeals for the Federal Circuit. State Street Bank & Trust Co. v. Signature Financial Group, 149 F.3d 1368 (Fed. Cir. 1998). Data processing apparatus for manipulating data representing physical objects or activities is also recognized as patentable subject matter. See MPEP § 2106. Moreover, the Board of Patent Appeals and Interferences recently restated that a “technological arts” test is not the appropriate metric by which to measure an invention’s patentability under 35 U.S.C. § 101.

See Ex Parte Lundgren, Appeal No. 2003-2088 (B.P.A.I. 2005).

Claims 1-9 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,405,177 (“DiMattina”). Claims 1-9 have been canceled, so this rejection is now moot. To the extent that new claims 10-28 incorporate elements similar to those of canceled claims 1-9, Applicant respectfully submits that the system of DiMattina does not teach or suggest every element of Applicant’s aspects, as recited by Applicant’s claims.

Applicant understands the system of DiMattina to relate to securing commercial transactions on-line. More specifically, a customer who wishes to make a purchase online from an electronic retailer (an “e-tailer”) is given a choice to “secure” the transaction by purchasing, for an additional price and from a third-party insurer/guarantee provider, insurance that contains certain guarantees in connection with the online purchase. See col. 3, line 48 - col. 4, line 21; col. 5, lines 23-31. The insurance purchased by the customer in the system of DiMattina reduces potential loss to the customer associated with the online purchase, for example, by covering nongenuine goods or covering losses to the consumer of stolen identity information. Notably, the system of DiMattina involves a commercial transaction requiring three entities, the seller (or e-tailer), the customer, and the insurer. The insurer appears to be involved only in the specific transaction between the e-tailer and the customer. The e-tailer sells goods or services to the customer, and the insurer offers for sale insurance to be purchased from a third party where the insurance is associated only with the particular goods or services to be sold to the customer in that transaction. Thus, the guarantee provider only offers the guarantee in connection with a particular transaction.

Conversely, Applicant’s claims are directed to a two-entity transaction directly between an insurance provider (an insurer) and an insurance purchaser (an insured) in a particular transaction. More specifically, the insurer according to Applicant’s claims offers a variety of insurance coverages that may be independent of a particular transaction between the insured (e.g., an e-tailer) and a third party (e.g., an end customer). The insured conducts at least a portion of its business on the Internet, and the insurer offers certain types of insurance coverages to reduce the insured’s liabilities to third parties that potentially arise from conducting business

on the Internet. The insured is able to purchase the insurance policy independently of any other transaction and potentially covering all activities conducted on the Internet.

Consequently, unlike the system of DiMattina, Applicant's claims are directed to a situation in which the price of the insurance policy is not added as an itemized cost to an already-established price for the sale of the e-tailer's goods or services associated with a particular transaction. Thus, according to Applicant's claims, for example, an e-tailer can purchase an insurance coverage from the insurer for all of the e-tailer's business conducted online, such as insurance to protect against liability resulting from advertising or marketing business conducted on the Internet, professional services rendered via the Internet, third party liability for business conducted on the Internet, or network security when conducting business on the Internet.

For at least the reasons discussed above, Applicant respectfully submits DiMattina does not teach or suggest every limitation recited by Applicant's claims. Accordingly, it is respectfully submitted that claims 10-28 are allowable. Favorable consideration of the claims is respectfully requested.

If Applicant's new claims are rejected over DiMattina, the Examiner is respectfully requested to associate each element in Applicant's claims with corresponding elements in DiMattina and quote verbatim the language regarded as suggesting Applicant's claim language.

CONCLUSION

In view of the foregoing remarks, and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the pending claims are submitted to be in a condition for allowance, and a notice to that effect is earnestly solicited.

If there are any issues that remain, the undersigned requests that the Examiner contact him to discuss these issues so that Applicant may put the present application in condition for allowance.

Respectfully submitted,



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Date: July 13, 2006